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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,421	10/09/2003	Janice Marie Girouard	AUS920030749US1	9616

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EXAMINER

DAILEY, THOMAS J

ART UNIT	PAPER NUMBER
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2196

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/682,421

Applicant(s)

GIROUARD ET AL.

Examiner

Thomas J. Dailey

Art Unit

2196

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9 October 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 are pending in this application.
2. Claims 5, 13, and 21 are cancelled by the preliminary amendment received March 25, 2005.
3. Claims 1-4, 6-12, 14-20, and 22-24 are being considered for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-20 and 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. As to claim 17, as provided in paragraph [0028] of the specification, a machine-readable medium includes "transmission media" which includes "coaxial cables, copper wire or fiber optics, [and] acoustic or light waves." Claims drawn to components involving signals encoded with functional descriptive material do not fall within any of the categories of statutory subject matter as set forth in 35 U.S.C. 101, and are therefore, ineligible for protection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 7-12, 15-20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hursey et al. (US Pub. No. 2003/0023875 A1), hereafter "Hursey", in view of Smithson et al. (US Pat. No. 6,898,715 B1), hereafter "Smithson".
7. As to claim 1, Hursey discloses a method for mitigating self-propagating electronic mail viruses (Abstract), comprising:
 - receiving a request to send an electronic mail message with a file attachment to at least one intended recipient ([0033], lines 3-11 and [0035], lines 3-5);
 - comparing a characteristic of said at least one intended recipient with a maximum recipient limit ([0033], lines 11-13); and
 - responsive to said characteristic of said at least one intended recipient exceeding said maximum recipient limit ([0033], lines 14-16), requesting a sender authorization prior to sending said electronic mail message ([0033], lines 16-20), such that if a

Art Unit: 2196

virus is attempting to self-propagate by sending said electronic mail message said attempt is mitigated ([0033], lines 20-25).

Hursey does not disclose retrieving a maximum recipient limit specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment.

Smithson discloses retrieving a maximum recipient limit (column 4, lines 24-44) specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment (column 4, lines 50-53).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey and Smithson in order to control the spread of specific file types that have a higher likelihood of containing viruses.

8. As to claim 9, Hursey discloses a system for mitigating self-propagating electronic mail viruses, comprising:
 - a computing system communicatively connected to a network ([0007]);
 - said computing system further comprising:

means for receiving a request to send an electronic mail message with a file attachment to at least one intended recipient ([0033], lines 3-11 and [0035], lines 3-5);

means for comparing a characteristic of said at least one intended recipient with a maximum recipient limit ([0033], lines 11-13); and

means for responsive to said characteristic of said at least one intended recipient exceeding said maximum recipient limit ([0033], lines 14-16), requesting a sender authorization prior to sending said electronic mail message ([0033], lines 16-20), such that if a virus is attempting to self-propagate by sending said electronic mail message said attempt is mitigated ([0033], lines 20-25).

Hursey does not disclose means for retrieving a maximum recipient limit specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment.

Smithson discloses means for retrieving a maximum recipient limit (column 4, lines 24-44) specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment (column 4, lines 50-53).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey and Smithson in order to control the spread of specific file types that have a higher likelihood of containing viruses.

9. As to claim 17, Hursey discloses a computer program product for mitigating self-propagating electronic mail viruses, comprising:

a recording medium ([0041], lines 6-9);

means, recorded on said recording medium, for receiving a request to send an electronic mail message with a file attachment to at least one intended recipient ([0033], lines 3-11 and [0035], lines 3-5);

means, recorded on said recording medium, for comparing a characteristic of said at least one intended recipient with a maximum recipient limit ([0033], lines 11-13); and

means, recorded on said recording medium, for responsive to said characteristic of said at least one intended recipient exceeding said maximum recipient limit ([0033], lines 14-16), requesting a sender authorization prior to sending said electronic mail message ([0033], lines 16-20), such that if a virus is attempting to self-propagate by sending said electronic mail message said attempt is mitigated ([0033], lines 20-25).

Hursey does not disclose means for retrieving a maximum recipient limit specified for a particular extension type of file attachment from among a plurality of

extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment.

Smithson discloses means for retrieving a maximum recipient limit (column 4, lines 24-44) specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment (column 4, lines 50-53).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey and Smithson in order to control the spread of specific file types that have a higher likelihood of containing viruses.

10. As to claims 2, 10, and 18, Hursey discloses:

comparing said characteristic of said at least one intended recipient with a maximum recipient limit for said electronic mail message ([0033], lines 11-13); and

responsive to said characteristic of said at least one intended recipient exceeding said maximum number of recipients for said electronic mail message ([0033], lines 14-16), requesting a sender authorization prior to sending said electronic mail message ([0033], lines 16-20).

11. As to claims 3, 11, and 19, Hursey discloses detecting a file embedded within said electronic mail message as a file attachment ([0037], lines 9-12).

12. As to claims 4, 12, and 20, Hursey discloses:

comparing at least one address for said at least one intended recipient with an address book of a plurality of recipients ([0033], lines 3-14);

calculating a number of said at least one address of said at least one intended recipient matching addresses within said address book of said plurality of recipients ([0033], lines 3-11); and

determining whether a number of said matching addresses exceeds a maximum limit of addresses within said address book of said plurality of recipients ([0033], lines 11-16).

13. As to claims 7, 15, and 23, Hursey discloses receiving said maximum recipient limit from at least one of a network administrator and a user ([0033], lines 11-14).

14. As to claims 8, 16, and 24, Hursey discloses responsive to receiving a denial of said sender authorization, alerting a network administrator that said electronic mail message was blocked ([0033], lines 25-28).

15. Claims 6, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hursey in view of Smithson as applied to claim 1,9, and 17 respectively above, in further view of Henderson (US Pat. No. 6845448 B1).

Art Unit: 2196

16. As to claims 6, 14, and 22, Hursey and Smithson do not explicitly disclose requesting at least one of an entry of a password as authorization and a manual sender input.

Henderson discloses requesting at least one of an entry of a password as authorization and a manual sender input (column 1, lines 65-67 and column 2, lines 1-2).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey and Smithson, with the teaching of Henderson in order to provide secure transmission of electronic mail messages (column 1, lines 65-67).

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 2196

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TJD


NABIL M. EL-HADY
SUPERVISORY PATENT EXAMINER